

REMARKS**Rejection and/of Objections of Claims and Traversal Thereof**

In the November 22, 2010 Office Action:

Claims 10, 21 and 30 were objected for because of formalities:

Claims 26 and 30 were rejected under 35 U.S.C. §112, second paragraph;

Claims 23, 25, 26, 28 and 29 were rejected under 35 U.S.C. §112, first paragraph; and

Claims 21-24, 27, 28, 30 and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by or in the alternative under 35 U.S.C. §103(a) over Tang, et al (WO 01/77169); and

Claims 10, 21-24, 27 and 28 were rejected under 5 U.S.C. §102(b) as being anticipated by or in the alternative under 35 U.S.C. §103(a) over Warren, et al. (WO 02/060492).

These rejections are hereby traversed and reconsideration of the patentability of the pending claims is therefore requested in light of the following remarks.

Claim Objections

Claims 10 and 30 have been cancelled. Claim 21 has been amended according to the suggestion of the Office. Applicants request withdrawal of these objections.

Rejection under 35 U.S.C. §112, second paragraph

Claims 26 and 30 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as

the invention. Applicants have cancelled claims 26 and 30 thereby obviating this rejection. Withdrawal of this rejection is requested.

Rejection under 35 U.S.C. §112, first paragraph

Claims 23, 25, 26, 28 and 29 were rejected under 35 U.S.C. §112, first paragraph for numerous reasons, each of which is addressed hereinbelow.

Claim 21 was amended to clearly define the step required to identify binding partners and if such binding partners affect the Wnt signaling activity of the Futrin 2 polypeptide, as set forth below:

21. A method of identifying a binding partner for a Futrin 2 polypeptide that affects Wnt signaling activity of the polypeptide, the method comprising:

- (a) contacting said Futrin 2 polypeptide with a compound to be screened; and
- (b) determining if binding of the compound to the Futrin 2 has occurred thereby forming a Futrin 2/ binding partner complex; and
- (c) assaying the Futrin 2/binding partner complex to determine if the Wnt signaling activity of the Futrin 2 polypeptide is altered.

Support for the amendment to claim 21 can be found on pages 28 and 29 of the specification and additionally in Examples 3 and 4. Due to the amendment of claim 21, the claim now meets all requirements of section 112. Claim 23 has been amended to clearly recite the additional steps of the method according to claim 21. Applicants request withdrawal of all rejections relating to enablement, written description and new matter.

Rejections under 35 U.S.C. §102(b)/103(a)

1. Claims 21-24, 27, 28, 30 and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by or in the alternative under 35 U.S.C. §103(a) over Tang, et al (WO 01/77169). Applicants submit that this reference does not in any way anticipate or render obvious the presently claimed invention.

As stated above, the present invention recites a method of determining a binding partner that affects Wnt signaling activity of the Futrin 2 polypeptide. It is evident that such an activity is not disclosed in the Tang reference. The comment by the Office that it inherently occurs is pure speculation and it is well settled in the law that to use the “inherency” rejection the event must occur each and every time. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *In re Oelrich*, 212 USPQ 323 (CCPA 1981).

Further, this Tang reference does not meet the requirements to establish a *prima facie* case of obviousness. It is intuitive that something that is unknown could not possibly be obvious.

The Court’s decision in *In re Spormann*, 150 USPQ 449 (CCPA 1966), bears directly on point:

“The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown”

Therefore, how could a skilled artisan make any modification while arriving at an invention that possesses the heretofore unknown characteristic. There is no disclosure in Tang to determine if a binding partner of Futrin 2 could alter the Wnt signaling activity. While it is possible that, serendipitously, the invention would have such a feature, serendipity is not a valid basis for asserting obviousness.

Thus, this Tang reference does not defeat the patentability of the presently claimed invention.

2. Claims 10, 21-24, 27 and 28 were rejected under 5 U.S.C. §102(b) as being anticipated by or in the alternative under 35 U.S.C. §103(a) over Warren, et al. (WO 02/060492). Applicants submit that this reference does not in any way anticipate or render obvious the presently claimed invention.

As stated above, the present invention recites a method of determining a binding partner that affects Wnt signaling activity of the Futrin 2 polypeptide. It is evident that such an activity is not disclosed in the Warren reference. The comment by the Office that it inherently occurs is pure speculation and it is well settled in the law that to use the “inherency” rejection the event must

occur each and every time. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *In re Oelrich*, 212 USPQ 323 (CCPA 1981).

Further, this Warren reference does not meet the requirements to establish a *prima facie* case of obviousness. It is intuitive that something that is unknown could not possibly be obvious.

The Court's decision in *In re Spormann*, 150 USPQ 449 (CCPA 1966), bears directly on point:

“The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown”

Therefore, how could a skilled artisan make any modification while arriving at an invention that possesses the heretofore unknown characteristic. There is no disclosure in Warren to determine if a binding partner of Futrin 2 could alter the Wnt signaling activity. While it is possible that, serendipitously, the invention would have such a feature, serendipity is not a valid basis for asserting obviousness.

Thus, this Warren reference does not defeat the patentability of the presently claimed invention.

Applicants request reconsideration and the withdrawal of all rejections under section 102(b) and/or section 103(a).

Fees Payable

Applicants added three new claims but do not owe any additional funds because of the cancellation of numerous claims. If any additional fee is found due for entry of this amendment, the Commissioner is authorized to charge such fee to Deposit Account No. 13-4365 of Moore & Van Allen.

Conclusion

Applicants have satisfied the requirements for patentability. All pending claims are free of the art and fully comply with the requirements of 35 U.S.C. §112. It therefore is requested that Examiner Marvich reconsider the patentability of the pending claims in light of the distinguishing remarks herein, and withdraw all rejections, thereby placing the application in condition for allowance. If any issues remain outstanding incident to the allowance of the application, Examiner Marvich is requested to contact the undersigned attorney at (919) 286-8089.

Respectfully submitted,

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